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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,103	12/11/2001	Alex Mashinsky	5106-5	2650
7590	04/03/2009		EXAMINER	
COHEN, PONTANI, LIEBERMAN & PAVANE 551 Fifth Avenue, Suite 1210 New York, NY 10176			BORLINGHAUS, JASON M.	
		ART UNIT	PAPER NUMBER	
		3693		
		MAIL DATE	DELIVERY MODE	
		04/03/2009	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/014,103	<b>Applicant(s)</b> MASHINSKY ET AL.
	<b>Examiner</b> JASON M. BORLINGHAUS	<b>Art Unit</b> 3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 January 2009.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-39 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____          |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application<br>Paper No(s)/Mail Date _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____   |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/12/09 has been entered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1 – 39** are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering (US Patent 6,324,519) in view of Wagner (US Patent 4,903,201) and Curran (Curran, James; Seaton, Jean. *Power Without Responsibility: The Press and Broadcasting in Britain*. Routledge. 1997. p. 189).

**Regarding Claim 1**, Eldering discloses a system for trading media space, comprising:

- a server node (server) operatively connectable to user interfaces for receiving a request for media space (advertising space/opportunities) from a buyer (advertisers) and offers of media space (advertising space/opportunities) from sellers (content providers). (see abstract; fig. 1 and 7; col. 9, line 32 – col. 12, line 26);
- said requests (ad characterization) including expected audience characteristics (demographics) specified by the buyers (advertisers) and said offers (consumer characterization) comprising audience characteristics (demographics) specified by the sellers (content providers). (see col. 1, lines 45 – 67; col. 2, lines 5- 21);
- said server node (consumer profile server) comprising a set of rules (correlation operation) for automatically matching (correlating) the requests and the offers based on parameters (ad characterization and consumer characterization) specified in the requests and offers including the expected audience characteristics (demographics). (abstract; fig. 1

and 7; col. 1, lines 45 – 67; col. 2, lines 5- 21; col. 9, line 32 – col. 12, line 26); and

- wherein said server node (server) configured to facilitate delivery of media content (advertisement) between the matched (correlated) buyer (advertiser) and seller (content provider) in response to the executed trade (accepted bid). (see col. 1, lines 45 - 55).

Eldering does not explicitly teach a system wherein said requests and offers are stored in a database of the server, although Eldering does recognize that storage of information within the system would be required, as Eldering discloses the usage of a database (see col. 8, lines 60 – 65) and data storage devices, such as hard drives (see fig 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Eldering by incorporating a database, as disclosed by Eldering, for storage of submitted requests and offers for advertising, allowing for storage of data to be processed by the system to be stored within the system.

Eldering does not explicitly teach a system wherein said offers comprise guaranteed audience characteristics, although Eldering does recognize that an offer comprises audience characteristics. As the guaranteed characteristics are not specified, the disclosure of Eldering may suffice depending upon the definition of the guaranteed characteristic.

Nonetheless, Curran discloses a system wherein offers comprise guaranteed audience characteristics. (see p. 189).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Eldering to incorporate guaranteed audience characteristics, as disclosed by Curran, as purchasing of media space based upon guaranteed audience characteristics is standard and conventional in the art of advertising.

Eldering does not teach the inclusion of a deal execution requirement for executing at least one trade between a matched buyer and seller in accordance with the deal execution requirement, although Eldering does disclose a deal execution stage (selection of bid) for executing at least one trade between a matched (correlated) buyer (advertiser) and seller (provider) in accordance with the deal execution stage. (emphasis added - see abstract).

To that end, Wagner discloses a system for trading wherein there is the inclusion of a deal execution requirement should a match between a buyer's request and a seller's offer and the exercising of such an execution requirement (executes matching bids and offers). (see col. 20, line 54 – col. 21, line 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Eldering and Curran by incorporating such features, as disclosed by Wagner, as such features and/or activities are conventional

and standard in the operation of matching or trading systems, allowing a matched request and offer to proceed to transaction completion.

**Regarding Claims 2 - 3,** Eldering discloses a system for trading media space further comprising:

- wherein said server node (server) is further configured for sending (transmitting) notice of the match (correlation results) to the matched buyer and seller. (see col. 10, lines 20 – 36); and
- a delivery system (network) having a switching node (Internet) connected to between said server node (customer profile server), a buyer's content database (ad server) and a seller's content database (content server), wherein the media content (advertisement) is delivered from the buyer's content database (ad server) to the seller's content database (content server) via said switching node (internet). (see abstract; fig. 1 and 7; col. 9, line 32 – col. 12, line 26).

Eldering does not teach a system wherein said server node is further configured for sending notice of the executed trade to the matched buyer and seller.

To that end, Wagner discloses a system for trading wherein said server is further configured for sending notice of the executed trade to the matched buyer and seller (notifies traders of filled or unfilled orders). (see col. 20, line 54 – col. 21, line 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Eldering, Curran and Wagner by incorporating such features, as disclosed by Wagner, as such features and/or activities are

conventional and standard in the operation of matching or trading systems, allowing traders to be notified of a trade.

**Regarding Claim 4,** Eldering discloses a system for trading media space further comprising:

- wherein said delivery system further comprises a contents database (ad server) connected to a network and configured to store media content (variety of advertisements), the delivery system being configured to receive the media content from the buyers (advertiser) when the requests (request for advertising space/opportunities) are submitted to the server node (server) and storing the media content (variety of advertisements) in the content database (ad server), and the delivery system being configured to deliver the media content (advertisement) from the content database (ad server) to the one of the sellers (content providers) of the matched (correlated) pair via the switching node (internet). (see abstract; fig. 1 and 7; col. 4, lines 8 – 11; col. 9, line 32 – col. 12, line 26);
- wherein said connection to said buyer's content database (ad server) and said seller's content database (content server) via a file transfer means (transport protocols). (see abstract; fig. 1 and 7; col. 9, line 32 – col. 12, line 26);
- wherein said switching node (internet) to said buyer's content database (ad server) and said seller content database (content server) via a file transfer means (transport protocols) consisting of one of an IP network

(Internet) and e-mail system (e-mail messages). (see abstract; fig. 1 and 7; col. 9, line 32 – col. 12, line 26);

- wherein said delivery system (network) further comprises a contents database (web site) connected to means for receiving and storing the offered media content (listing of advertising opportunities) from the sellers (content provider) when the offers (advertising space/opportunities) are submitted to the server node (web site) and storing the offered media content (listing of advertising opportunities) in the contents database (web site), and means for delivering (Internet) the content media (advertisement) from the buyer (advertiser) to the seller (content provider) of the matched (correlated) pair. (abstract; fig. 1 and 7; col. 1, lines 45 – 67; col. 2, lines 5- 21; col. 9, line 32 – col. 12, line 26); and
- wherein said server node (server) is connectable to the buyers and the sellers via a wide area communication network (Internet). (see abstract; fig. 1 and 7; col. 9, line 32 – col. 12, line 26).

Eldering does not teach the use of a third content database.

As to the third content database, neither the combination of two databases into a third database (the third database being an amalgamation of the prior existing two) nor the creation of an additional third database (the third database operating in addition to the prior existing two database) make the claim limitation patentably distinct. In regards to the combination, the courts have stated that forming in one piece an article that had formerly been formed in two pieces and put together involves only routine skill in the art.

*Howard v. Detroit Stove Works, 150 U.S. 164 (1893); In re Larson, Russler & Meldahl, 340 F.2d 965, 967, 144 USPQ 347, 349 (CCPA 1965).* In regards to database duplication, the courts have also stated that mere duplication of the essential working parts of a device, without more, involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co, 193 USPQ 8 (CA 7); In re Harza, 124 USPQ 378 (CCPA 1960).*

Regar

**Regarding Claim 15,** Eldering also does not teach a clearinghouse module connected to said server node configured to perform one of clearing, settlement or billing for the executed trade.

To that end, Wagner discloses a system for trading wherein there is the inclusion of a module to perform one of clearing (executes and clears trades simultaneously) billing, and settlement (provides necessary trade data for settlement). (see col. 20, line 54 – col. 21, line 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Eldering, Curran and Wagner by incorporating such features, as disclosed by Wagner, as such features and/or activities are conventional and standard in the operation of matching or trading systems, allowing a matched request and offer to proceed to transaction completion.

**Regarding Claim 16 – 20,** Eldering discloses a system:

- wherein the media space is an ad space on one of television (broadcast video programming). (see col. 1, lines 38 – 44);

- wherein the media space includes attributes comprising at least one target market (demographics). (see col. 2, lines 11 – 14);
- wherein the buyers and sellers are market participants, wherein the market participants comprise at least one of an advertiser (advertiser). (see fig. 1A); and
- wherein further comprising an interface (Internet) through which the buyers and sellers interact with said server node, said interface comprising at least one of a computer. (see col. 8, line 40 – col. 9, line 5).

Eldering does not teach the presentation of an input screen to the buyer and seller for the request and the offer, although Eldering does teach the input of information by the buyer and seller into a computer system and generally computer systems operate with a screen or display. (emphasis added)

Regardless, Wagner discloses an input screen for the buyer and seller to input their request and offer. (see fig. 19).

It would have been obvious to one of ordinary skill in the art to have modified Eldering, Curran and Wagner by incorporating an input screen, as disclosed by Wagner, allowing a visual interface to facilitate the inputting of data into the system, thereby increasing ease of use for the system.

**Regarding Claim 35,** Eldering discloses a system wherein each of said requests and offers comprise parameters (vectors) and said set of rules matches the request and offers based on at least one of the parameters (vectors) that is different from the

cost of the media space (such as demographic matching or product preference matching). (see col. 1, line 45 – line 2, line 14).

**Regarding Claims 9 – 14, 21 – 34 and 36 – 37,** such claims recite substantially similar limitations as claimed in previously rejected claims. Such claim limitations are therefore rejected using the same art and rationale as previously utilized.

**Regarding Claim 38,** Eldering does not disclose a method further comprising validating at least one of the requests and the offers.

Wagner discloses a method further comprising validating at least one of the requests and the offers. (see col. 14, line 45 – col. 15, line 5).

It would have been obvious to one of ordinary skill in the art to have modified Eldering, Curran and Wagner by incorporating a validating procedure, as disclosed by Wagner, thereby ensuring the validity of inputted data prior to processing.

**Regarding Claim 39,** such claims recite substantially similar limitations as claimed in previously rejected claims. Such claim limitations are therefore rejected using the same art and rationale as previously utilized.

**Examiner's Note:** The Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures

may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

***Response to Arguments***

Applicant's arguments filed 3/10/08 have been fully considered but they are not persuasive.

**Audience Characteristics**

Applicant argues that "Eldering does not require a seller to specify a guaranteed audience characteristic because Eldering determines a consumer profile of an offer based on metrics stored in a consumer profiler."

Examiner is uncertain concerning the nature of the Applicant's argument.

Is the Applicant's argument that the seller fails to specify the information because it is pre-existing within the consumer profile server? If such is the case, then it is inherent that a party must have at one time specified the information for its inclusion and storage within the consumer profile server.

Is the Applicant's argument that the specification of information is being performed by the consumer profiler and not the seller?

First, whether the specification of information is being performed by the consumer profiler or the seller fails to distinguish the claimed invention from the prior art. In the prior art, a party enters information into the system concerning the audience characteristics concerning the advertising opportunity to be sold. Whether the party is consumer profiler or the seller is immaterial.

Second, Eldering discloses that functions performed by the consumer profiler could be combined with the functions performed by the seller. To such end, Eldering states:

The correlation can be performed by profiler 140, content/opportunity provider 160, or may be performed in part by each of these entities. (see col. 7, lines 58 – 60).

And

As an example of the industrial applicability of the invention, the advertisement auction system can be utilized by a cable television operator to solicit and accept bids for advertisements placed in commercial times during broadcast programming. In this application the cable television operator acts as content/opportunity provider 160. The profiler 140 may also be the cable operator, the consumer 100, or a third party paid for access to the consumer profile. (see col. 11, lines 6 – 13 – emphasis added).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON M. BORLINGHAUS whose telephone number is (571)272-6924. The examiner can normally be reached on Monday - Friday; 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on (571)272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/  
Supervisory Patent Examiner, Art Unit 3693

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/Jason M Borlinghaus/  
Examiner, Art Unit 3693

July 2, 2008